



MAR 29 2005 TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No.
1421-58 DIV II

In Re Application Of: Jani et al.

Application No. 10/664,427	Filing Date August 26, 2003	Examiner S.L. Kuhns	Customer No. 23869	Group Art Unit 1761	Confirmation No. 4535
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Invention: APPARATUS FOR MAKING A CENTER-FILLED GUM LOLLIPOP WITH HARD CANDY SHELL

COMMISSIONER FOR PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

January 24, 2006

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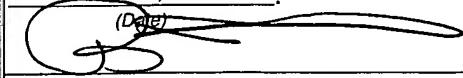
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant(s): Jani, et al.

Examiner: Kuhns, S. L.

Application: 10/664,427

Group Art Unit: 1761

Filed: August 26, 2003

Docket: 1421-58 DIV II

Confirmation No: 4535

Date: March 27, 2006

For: APPARATUS FOR MAKING A
CENTER-FILLED GUM LOLLIPOP
WITH HARD CANDY SHELL

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APPEAL BRIEF PURSUANT TO 37 CFR §41.37

Sir:

This is an appeal to the Board of Appeals from an Action mailed August 26, 2005 marked final and the subsequent Advisory Action mailed January 19, 2006, in which the Examiner finally rejected Claims 18-21 of the above-identified application. Appellants timely filed a Notice of Appeal on January 24, 2006. This Notice of Appeal was received at the U.S. Patent and Trademark Office on January 27, 2006. Therefore, the due date for filing the Appeal Brief is Monday, March 27, 2006. This brief is being filed in support of that Notice of Appeal.

As required by 37 C.F.R. §41.37, a single copy of this brief is being filed with the filing fee of \$500.00. Please charge the fee to Deposit Account No. 08-2461. Kindly charge or credit any fees or overpayments, respectively, to Deposit Account No. 08-2461.

1. REAL PARTY IN INTEREST

The real party in interest in the present appeal is Cadbury Adams USA LLC, a company registered in the state of New Jersey, having acquired rights by way of an assignment recorded in the United States Patent and Trademark Office at Reel 014108, Frame 0261.

2. RELATED APPEALS AND INTERFERENCES

No related appeals or interferences are known to Appellants or Appellants' legal representative which will directly affect or be directly affected by or have bearing on the Board's decision in this appeal.

3. STATUS OF THE CLAIMS

Claims 18-21 are presently pending in the application. Claims 18-21 stand finally rejected. The rejections of 18-21 are being appealed.

Claims 18-21 have been rejected under 35 U.S.C. §103 as allegedly unpatentable over U.S. Patent No. 5,667,824 to Ream et al. ("Ream") in view of U.S. Patent No. 4,975,288 to Hager et al ("Hager"), U.S. Patent No. 810,210 to Laws ("Laws"), U.S Patent No. 3,062,662 to McDonald ("McDonald"), and the press release to "LMC International".

4. STATUS OF AMENDMENTS

No amendments have been made to the claims subsequent to the final rejection.

5. SUMMARY OF CLAIMED SUBJECT MATTER

The present invention includes a method of making a three-material lollipop product which includes a candy coated, center-filled gum. The lollipop is prepared by (1) extruding a gum material, (2) transporting the extruded gum to a batch forming mechanism, (3) injecting a center-fill into the gum, (4) coating the gum material with a molten candy material, and (5) forming individual lollipop balls from said candy coated gum material in a lollipop forming mechanism.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issue on appeal includes:

I. Are Claims 18-21 obvious over Ream in view Hager, Laws, McDonald, and LMC International?

7. ARGUMENTS

I. Claims 18-21 are patentable over Ream in view of Hager, Laws, McDonald, and LMC International.

Claims 18-21 have been rejected under 35 U.S.C. §103 as allegedly unpatentable over U.S. Patent No. 5,667,824 to Ream et al. (“Ream”) in view of U.S. Patent No. 4,975,288 to Hager et al (“Hager”), U.S. Patent No. 810,210 to Laws (“Laws”), U.S Patent No. 3,062,662 to McDonald (“McDonald”), and the press release to “LMC International”. Appellants respectfully traverse these rejections on the grounds that the Examiner has failed to establish a *prima facie* case of obviousness. Specifically, the references include no motivation to modify or combine the references, the teachings of the references are not properly combinable, and even if combined, the references fail to teach the invention as claimed. Therefore, reconsideration and withdrawal of the rejections are respectfully requested.

M.P.E.P §2143 states the “Basic Requirements of a *Prima Facie* Case of Obviousness. In order to establish a *prima facie* case of obviousness, (1) a reference or combination of references must provide some suggestion or motivation to modify the reference or to combine the teachings; (2) there must be a reasonable expectation of success; and (3) there must be a teaching or suggestions of all claim limitations. The teachings must consider the reference as a whole and the proposed modification cannot render the prior art unsatisfactory for its intended purpose.

The Examiner has alleged at page 2 of the Office Action dated August 26, 2005 that the Appellants have impermissibly attacked the references individually in an attempt to show non-obviousness. Appellants respectfully submit this is not true. Given the numerous references that are combined by the Examiner, the Appellants first point out what each of the references teaches and then point out the reasons why the combination fails to provide a *prima facie* case of obviousness under Section 103.

The combination of Ream, Hager, Laws, McDonald, and LMC International fails to establish a *prima facie* case of obviousness because (1) there is no motivation to combine the references, (2) there is no reasonable expectation of success and (3) the combination of the reference renders the prior art unsatisfactory for its intended purpose.

Important aspects of the requirements for motivation to combine and expectation of success are that both must come from the prior art and not from the disclosure of the present invention. According to MPEP §2143, “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.”

The Examiner states that the motivation to combine the references is found in the Office Action dated February 9, 2005 where it states, “It therefore would have been obvious to inject gum formed by the method of Ream with a center-fill semi-liquid material, as taught by Hager

and Laws, in order to incorporate additional flavors and keep the gum in its moist and plastic condition for along time.” However, this is actually contrary to the purpose of Hager. Hager seeks to provide a center-fill gum which provides the separate sensation of liquid upon chewing. Laws provides a center-fill gum with the intention that the center-fill will migrate into the surrounding gum which keeps the gum in its “moist and plastic condition” not to prevent such migration as is sought by Hager. In other words, Hager seeks to maintain the separate liquid layer, while Laws does not.

Ream teaches a method of preparing a miniature confection which is preferably a gum. In Ream’s method, a sheet of gum material is extruded and then cooled and formed into a “webbed sheet” by passing the gum sheet through a series of rollers. The “webbed sheet” is removed as a whole and individual gum pieces are broken off of the mat. Cooling is an essential step of the Ream method as the low temperature is required to prevent tackiness and may be achieved through a nitrogen cooling system. See Ream column 4, lines 21-24. There is no teaching or suggestion in Ream to provide a gum piece which is center-filled or includes a candy coating.

Hager provides a method of preparing a center-filled chewing gum which provides an advantage over prior methods of preparing center-filled gums in that the gum pieces may include 35-40% by weight center-fill. This is compared to prior methods which could only achieve 12-17% by weight center-fill. The center-filled gum is prepared from a filled extruded rope of gum, which is incompatible with the webbed mat forming device provided by Ream which requires a sheet of gum.

Laws teaches a method of preventing gum from becoming hard and brittle, which results in a commercially unacceptable product. Laws teaches forming hollow chewing gum tubes and filling the individual hollow gum pieces with a liquid which is absorbed into the gum piece to compensate for moisture lost as the gum dries. A moisture-resistant coating is first applied to the interior of the hollow tube to prevent the liquid center from transferring too quickly to the gum

piece. Laws does not provide a center-filled gum as in the present invention. The liquid added to the center is not meant to provide a “burst” of flavor upon chewing the gum piece as in Hager. Instead, the liquid is meant to be transferred to the gum material prior to reaching the consumer in order to “keep the piece of gum in its natural moist and plastic condition.” See Laws column 1, lines 23-24.

The method of Ream is itself not compatible with the preparation of a center-filled gum. Hager requires the preparation of a liquid filled rope and Laws requires the filling of a hollowed gum piece. Since Ream provides for neither the preparation of an extruded rope of gum nor a hollowed gum piece, the combination of the teachings of Ream with either Hager or Laws, the would not result in a center-filled gum piece.

Furthermore, to combine the teachings of Ream with either of the recited other references is improper absent some showing of motivation to combine them. In this case, not only is there no motivation, but any attempt to combine would require changes to Ream which would destroy that reference’s intent and purpose. Specifically, as Ream is directed to the preparation of a miniature confection which is detached from a webbed sheet, the method is not properly combinable with a method of preparing an extruded rope, or any center-filled gum.

Considering that there is no motivation to combine Ream with Hager and Laws, a *prima facie* case of obviousness has not been established. However, the Examiner further alleges a center-filled chewing gum may then be combined with a candy coating citing McDonald which teaches a candy coated gum confection and may further be formed into a ball shape citing LMC International which teaches a ball-shaped lollipop forming mechanism.

Assuming *arguendo* that the combination of Ream, Hager, and Laws does result in the formation of a center-filled gum composition, there is no teaching or motivation to modify such a chewing gum piece by adding a candy coating. McDonald does not teach or suggest, nor provide an mechanism for preparing a candy coated, center-filled chewing gum.

Although McDonald does provide a candy coated gum, McDonald specifies that the coating is applied by first placing a lollipop stick in a gum piece and then dipping the gum piece at least once into a hot (300 – 310F) candy syrup and then placed on a flat surface for cooling. The gum must stay in the syrup for a sufficient time “so that the bubble gum will partially melt and soften and mix with the candy.” Column 2, lines 54-55. Further, [t]he intermixing occurs while the candy is a heated liquid, saturating the bubble gum material, and form[ing] hardened brittle crystals and areas in and on the bubble gum materials when cooled so that a crunchy characteristic results.” Column 1, lines 36-40. The purpose of McDonald is to provide a combination of candy and gum where “the candy composition intermixes with a substantial part of the bubble gum material.” Column 1, lines 35-36.

Clearly, McDonald provides no motivation to modify its disclosure. Moreover, even if the method taught by McDonald is performed with a center-fill gum, one of ordinary skill in the art would have no expectation of success. McDonald does not contemplate the inclusion of a center-filled gum and therefore does not accommodate for the potential issues of leaking or moisture migration of the center. Melting the gum layer as required by McDonald would lead to a non-homogeneous layer adjacent to the liquid center that could result in leaking of the liquid center which is contained by the gum. Furthermore, the combination of the candy layer with the gum layer would likely eliminate the separate intermediate gum layer, as the gum would be combined with the hard candy.

McDonald requires the combination of a gum with the candy by melting the gum and candy together. McDonald is concerned only with solid gum centers which are dipped into hot candy syrup. It is clear from the teachings of McDonald that this dipping process was not intended for liquid-center-filled gums since to allow partial melting and softening of the candy with the gum will jeopardize the integrity of the center-filled gum as will impregnating the gum with hard candy crystals. As the Examiner is aware, there are many difficulties in producing and maintaining commercially viable center-filled gums and one of ordinary skill in the art would

avoid processes which might introduce additional problems such as premature migration. Thus one of ordinary skill in the art would not employ the process as taught by McDonald to coat a center-filled gum since using the method of McDonald would not provide one of ordinary skill in the art with a reasonable expectation of success.

In the Advisory Action dated January 19, 2006, the Examiner states that “while McDonald requires partially melting the gum to mix with the candy when applying the candy-coating, there is no evidence that such ‘partial melting’ would be sufficient to cause a liquid filled gum to leak the center liquid.” Appellants respectfully submit that this statement does not correlate to the requirements for a finding of obviousness, but is instead the reasoning associated with impermissible hindsight reconstruction.

The fact that there is no evidence that adding a candy coating and causing partial melting of a center-filled gum would be sufficient to cause a liquid filled gum to leak has no bearing on the fact that in order to provide a *prima facie* case of obviousness, there must be a reasonable expectation of success. To the contrary, there must be a reasonable expectation that the gum will not leak. There is no evidence either way to show that melting a center-filled gum either will or will not melt. However, by properly applying the standard and given that there are numerous problems associated with the leaking of center-filled gum, one of skill in the art will have no expectation of success of providing a candy coated center-filled gum by following the method of McDonald.

Also, as discussed above, neither McDonald nor the combination of Ream, Hager, and Laws provides a teaching or suggestion to provide a hard candy layer and an separate gum layer. The only teaching of a hard candy in combination with a gum layer is found in McDonald, wherein there are not two layers, but to the contrary, the gum and hard candy are mixed.

As stated in the Response dated July 11, 2005 and in the Response dated December 21, 2005, Appellants respectfully renew their assertion that the combination of McDonald and LMC

International do not provide a candy coated gum that may be shaped into a ball. The Examiner asserts at page 3 of the Office Action dated August 26, 2005 that it is “notoriously well known to shape lollipops into balls, as evidence by LMC International. As such, it would have been an obvious matter of choice to form the candies into conventional ball shapes instead of the bell shapes taught by McDonald.” Appellants respectfully submit that this is not a proper standard for establishing a *prima facie* case of obviousness.

Appellants acknowledge that LMC International teaches a mechanism for the formation of lollipop balls. However, LMC International does not provide any motivation to modify its teachings to prepare a candy-coated gum into a lollipop ball. The disclosure of LMC International is limited to lollipops. One following the teachings of LMC International would have no reasonable expectation of success of preparing a candy-coated lollipop ball considering that LMC International provides no teaching or suggestion that the device is compatible with a gum material.

With respect to McDonald, not only is there no teaching to provide the lollipop confection in a ball shape, McDonald teaches away from any other than the “bell-shaped” confection that results from the drying on the flat surface. McDonald requires the flat edge which is “a particularly desirably shape for the confections as it enables the same to be advantageously displayed for sale.” Column 2, lines 46-48. To modify the teachings of McDonald to prepare a ball-shaped confection is contrary to the intent and purpose of McDonald. Since the proposed modification would render the McDonald unsatisfactory for its intended purpose, the combination of McDonald and LMC International is insufficient to establish a proper *prima facie* case of obviousness.

For the reasons set forth above, there is no motivation in any of the references to combine the teachings of each. Even if combined, the references would not lead one of ordinary skill in the art to prepare the invention of the present claims.

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In view of the above amendments and remarks, Appellants respectfully submit that the present application, including claims 18-21 is now in condition for allowance. Favorable action thereon is respectfully requested.

8. CONCLUSION

Having set forth factual and legal basis which support the patentability of the claims on appeal, it is respectfully submitted that Claims 18-21 are in condition for allowance. Accordingly, Appellants respectfully urge the Board to reverse the Examiner's rejections of the claims.

Respectfully submitted,


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9. CLAIMS APPENDIX

Claims 1-17 (cancelled)

18. A method of making a three-material lollipop product, said steps comprising:
extruding a gum material from an extruder;
transporting said extruded gum material into a batch forming mechanism;
injecting a center-fill semi-liquid material into said gum material;
coating said gum material with molten candy material in said batch forming mechanism;
and
forming individual lollipop balls from said candy coated gum material in a lollipop forming mechanism.
19. The method as set forth in claim 18 further comprising the step of sizing said candy coated gum material in a sizing mechanism prior to forming individual lollipop balls in said lollipop forming mechanism.
20. The method as set forth in claim 18 further comprising the step of inserting sticks into said lollipop balls to form lollipop products.
21. The method as set forth in claim 20 further comprising the step of cooling said formed lollipop products.

Claims 22-24 (cancelled)

10. EVIDENCE APPENDIX

There were no declarations or other evidence submitted during the prosecution of this application.

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11. RELATED PROCEEDINGS APPENDIX

No related appeals or interferences are known to Appellants or Appellants' legal representative which will directly affect or be directly affected by or have bearing on the Board's decision in this appeal.